

Application No. 10/825,046
Response to Restriction Requirement Dated October 3, 2005
Office Action mailed September 22, 2005

REMARKS/ARGUMENTS:

Claims 1-11 are pending of which claims 9-11 are new. Method claim 9 corresponds as a method counterpart to that of claim 1. The applicant provisionally elects the apparatus claims 1-5 for further examination.

Restriction was made as to the following:

I. Claims 1-5 drawn to an apparatus, which the Office Action classified in class 604, subclass 181.

II. Claims 6-8 drawn to a method, which the Office Action classified in class 264, subclass 349.

The sole rationale given for imposing restriction was that the product as claimed can be made by another and materially different process such as injection molding.

The restriction requirement is respectfully traversed.

As an initial matter, the method claims are improperly assigned to class 264, subclass 349. Class 264 covers plastic and non-metallic article shaping or treating processes. Subclass 349 covers miscellaneous.

Assigning method claims to a "miscellaneous" subclass should give rise to a suspicion that an improper assignment is being made for claimed subject matter to that subclass. The method claims 6-8 do not cover "shaping or treating processes". Instead, they cover a method of forming a sterilized barrier without defining limitations concerning shaping or treating. While it is true that one of the steps calls for the sheath to be in an expanded condition, such an expansion is not attained through a process of shaping or treating within the meaning of class 264.

In particular, to fall under class 264, the description notes:

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The common property of plasticity renders molding operations of chief importance in this class...This class (264) will accommodate such subject matter only where the resulting compact tends to hold its shape as the result of an interfacial bond between adjacent particles of the mass.

None of the steps of the method claims 6-8, however, recite any attribute of plasticity, i.e., the ability of a material to retain its shape attained by pressure deformation, or interfacial bonds. Indeed, where the recited sheath is constructed of a resilient material, no pressure deformation forces need be applied at all for the sheath to remain in its expanded condition since it is being secured in the expanded condition.

Class 264 reads as follows:

SECTION I - CLASS DEFINITION

This is a generic class for:

- (1) Processes for molding, casting, or shaping of nonmetallic materials to produce articles.
- (2) Liquid or melt comminuting of materials other than glass or metal.
- (3) Uniting or compacting of bulk or randomly assembled particles.
- (4) Furnace Lining or repair.
- (5) Melt shaping in the absence of a mold or shaping surface, e.g., spheroidizing of particles.
- (6) Working or treatment of nonmetallic materials not otherwise provided for.

GENERAL STATEMENT OF CLASS SUBJECT MATTER

- (1) This is a generic class for processes for molding, casting or the plastic shaping, not provided for in any other class, of miscellaneous nonmetallic materials to make or reproduce articles of a definite shape, or the shaping and embossing of sheets of miscellaneous nonmetallic materials, not otherwise provided for.

The common property of plasticity renders molding operations of chief importance in this class.

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Where there exists an art class that can properly include all operations preliminary to a broad molding step, such operations, unless otherwise specified will be classified in such class. Where significant molding steps are combined with any other operations, the patents claiming such combinations, unless otherwise provided for will be included in this class and cross-referenced into the other class or classes involved. Note the lines between this class and other classes as set out below.

Where there is no class which could include such operations, the entire preparation of the material is included in this class, but only those are included in which the preliminary operations are performed for the purpose of preparing the material for molding. See the search notes below and the references to other classes for the shaping of specific materials, e.g., paper, sugar, tobacco, etc.

This class will take processes under the class definition, and where not otherwise specifically provided for, in which normally liquid materials are encapsulated. In general, this class will provide for processes in which the covering, encompassing or encasing material is formed or shaped from material in a fluent state.

(2) This is the generic class for processes, not elsewhere provided for, for shaping of material by a comminution or disintegration thereof from a molten or liquid state, wherein the cohesive nature of the material, per se, especially in the comminuted state during solidification thereof influences the shape or configuration of the discrete particles or elements formed. See subclass 5 and the notes thereto for the lines with other classes. For liquid comminution of glass or other vitreous materials and for comminution of liquid metal, see References to Other Classes, below.

(3) The uniting of bulk assembled particulate material either autogenously (see specific references to glass particles and metal particles below) or with added binder or adhesive in a mold or on a shaping surface are included herein, except those processes in which the mold constitutes nothing more than a depository and the particulate material charge is not disclosed to be shaped by said mold or depository prior to heating but changes its bulk shape only on fusion or melting to assume the configuration of said depository. See Lines With Other Classes below, with regard to mold filling or charging.

This class has been made the generic home for methods of compacting and briquetting bulk deposited or handled powdered or particulate matter usually predicated on the production of an interfacial bond between the individual particles. However, see References to Other Classes below for classes that take (1) agglomerating from finely divided solid nonmetallic, inorganic elements, e.g., carbon, wherein no binder, per se, is employed; (2) compacting by mechanical interlock such as results from a baling operation; and (3) mechanical forming of a distilland combined with a thermolytic distilling operation.

This class (264) will accommodate such subject matter only where the resulting compact tends to hold its shape as the result of an interfacial bond between adjacent particles of the mass. Since powder, granules and dust are not characterized by projecting portions which could facilitate a bonding by mechanical interlock, a disclosure or claim restricted to such types of particulate material is regarded as evidence that the product is rendered self-sustaining by interfacial bonding.

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With regard to glass particle uniting, in particular, a patent reciting placing of glass particles other than glass fibers or mineral wool in their final position in a mold, followed by autogenous uniting or sintering or fusion in the configuration or shape imparted by said mold, will be classified in this class (264) whether or not said particles are disclosed to maintain their individual identities to any degree. See References to Other Classes, below, for processes including a glass working step as therein defined, and for the line where glass fibers or mineral wool are placed onto a mold surface which fibers or mineral wool particles are heated on or subsequent to contact with the surface to fuse the particles with each other.

4) This class will be considered generic to processes for furnace lining formation or repair. (See Subclass References to the Current Class, below.)

5) This class will take shaping of molten materials where no mold or molding surface, per se, is employed, e. g., spheroidizing or rounding of particles, see this class, subclass 15 and the notes thereto.

6) This class will take treatment of nonmetallic materials not otherwise provided for. See the notes to Lines With Other Classes, "Treatment of Shaped Articles," and Subclass References to the Current Class, below. Patents disclosing working, mulling or kneading, per se, of plastic materials will go to this class except where specific materials are recited.

Unless otherwise provided for, the recitation in a claim of a significant molding step will bring a patent to this class. Significant molding operations include named injection molding, centrifugal casting, slush casting, casting of fluids on a forming surface to form a sheet or web, "spinning" into a specifically named bath as set out below, evaporative or solvent extractive "spinning" and combinations of two or more broad molding or shaping steps and other combinations as set out herein.

Such terms as "molding", "casting" (used generically) "extruding", "sheeting" and "forming" are considered to be merely broad or nominal operations for purposes of this class.

The intent must also be considered. If, for example, "extruding" is for discharging material from a chamber in chunks or gobs rather than for shaping, this is not enough for this class.

The production of "shapes" merely suitable for handling or bulk shipping, e.g., "sheets" or "sheeting" of no particular structure will not be considered significant molding in a, per se, operation. Also, where articles identified by name only are produced, a process will not be considered significant for this class unless there are included limitations and/or modifications unique to molding or shaping said named article.

This class will take combinations of broad molding plus preliminary physical or mechanical treatment wherein said treatment is disclosed to perfect the molding.

Patents reciting physical or mechanical treatment subsequent to a broad molding step, e.g., extruding or "spinning" plus stretching, casting with removal of solvent from the cast liquid and heating subsequent to removal of a molded article from the mold to complete cure or to vulcanize, will be placed in this class. Nominal return to ambient temperature is not considered to be an after treatment or a subsequent treatment within the scope outlined here.

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Therefore, it is clear that the method claims were improperly assigned in the Office Action to class 264 subclass 349.

Instead, the method claims clearly fall under class 604, subclass 181, i.e., the same class and subclass as the apparatus claims. Class 604 pertains to surgery, which pertains to the method claims as well as the apparatus claims. Subclass 181 of class 604 covers means moved by person to inject or remove fluent material to or from body inserted conduit, holder, or reservoir. Such a description is a fair characterization of the method claims.

Since the apparatus and method claims fall under the same class and subclass, the examiner has failed to make out a prima facie case for imposing restriction.

Indeed, the Office Action contends that the apparatus can be made by another and materially different process such as injection molding. This is curious finding given the assignment of the method claims to class 264 that provides:

Unless otherwise provided for, the recitation in a claim of a significant molding step will bring a patent to this class. Significant molding operations include named injection molding

The method claims 6-8, however, do not preclude the use of injection molding to form its components.

Further, to the extent that the terms "attaching" and "securing" are found in method claim 6, which method the Office Action contends excludes injection molding, the terms "attached" and "secured" are found in apparatus claim 1 and so such language in the apparatus claims would likewise exclude injection molding if there was merit to such a contention as to what the method claims exclude.


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While claim 6 also recites the step of pulling, there does not seem to be any other way to expand the sheath from a collapsed condition to an expanded condition over an aspiration tube as recited in both the method and apparatus claims and so no materially different process could be employed. The natural tendency of an expandable article at rest is to enter into its unexpanded (collapsed) condition. Thus, pulling is necessary for the article to enter into an expanded condition.

Withdrawal of the restriction is warranted. Alternatively, claims 1-5 and 9-11 should be considered on the merits since the language of the method claims are commensurate with each other.

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